

REMARKS

Claims 1-30, 32, 34-38 and 46-52 are pending in this application. By this Amendment, independent claims 1 and 21 are amended to incorporate some of the features of allowable claim 5, claim 4 is amended to further define the recited features, claims 5, 29, 30, 35 and 49 are amended to be consistent with the amendments to claims 1 and 21, and claims 51 and 52 are added. Support for the amendment to claim 4 can be found, for example, in Fig. 1. Support for added claims 51 and 52 can be found, for example, in original claims 1, 6, 21 and 37. No new matter is added. The attached Appendix includes annotated versions of claims 35 and 49 to assist the Examiner in understanding what is changed in these claims.

I. Allowable Subject Matter

Applicants appreciate the indication that claims 5, 17-20, 32, 35-38, 46, 47, 49 and 50 recite allowable subject matter, and would be allowable if rewritten in independent form including all of the features of the base claim and any intervening claims. As discussed above, independent claims 1 and 21 are amended to incorporate some of the features of claim 5.

II. Objection to Claim 47

The Office Action objects to claim 47 as allegedly having the same scope as claim 46. The objection is respectfully traversed. Claim 46 recites that the descriptive data is recorded after the coating thickness values are recorded. That is, all of the coating thickness values are recorded, and then all of the descriptive data are recorded. Claim 47 recites that each of the descriptive data is recorded after the respective coating thickness value is recorded. That is, an individual coating thickness value is recorded, and then its respective descriptive data is recorded. Thus, in claim 46 all of the coating thickness values are recorded before any of the

descriptive data are recorded. In claim 47, on the other hand, an individual coating thickness value is recorded, its respective descriptive data is recorded, and then a subsequent individual coating thickness value is recorded. Accordingly, the scopes of claims 46 and 47 are different. Therefore, withdrawal of the objection is respectfully requested.

III. 35 U.S.C. §102(b) Rejection over Kubo

The Office Action rejects claims 1, 6-8, 21, 24, 25 and 27-30 under 35 U.S.C. §102(b) over Kubo, JP-A-59-180322. The rejection is respectfully traversed.

Kubo fails to disclose a method and apparatus for recording coating thickness measurements in which a plurality of descriptive data are recorded by transforming text entered on a computer screen with an input device into digital data, as recited in independent claims 1 and 21.

Kubo discloses a film thickness distribution display method and device that includes a measurement element 24 that is pressed against a surface to be measured to take a measurement of the film thickness (see Abstract). The measurement data is stored and processed by a signal processor to be displayed using "constant pressure lines" 41 (see Abstract and Figs. 5 and 6). The Office Action asserts that the constant pressure lines 41 produced from the measurement data corresponds to the claimed descriptive data. However, Kubo does not disclose that the constant pressure lines 41 are recorded by transforming text entered on a computer screen with an input device into digital data, as recited in independent claims 1 and 21. Thus, independent claims 1 and 21 are patentable over Kubo.

Because claims 6-8, 24, 25 and 27-30 incorporate the features of claims 1 and 21, respectively, these claims also are patentable over Kubo for at least this

reason, as well as for the additional features these claims recite. Thus, it is respectfully requested that the rejection be withdrawn.

IV. 35 U.S.C. §102(e) Rejection over Elsmore

The Office Action rejects 1, 2, 4, 6, 8, 9, 21, 23, 25, 26, 28, 30, 34 and 48 under 35 U.S.C. §102(e) over Elsmore, U.S. Patent No. 5,416,411. The rejection is respectfully traversed.

Elsmore fails to disclose a method and apparatus for recording coating thickness measurements in which a plurality of descriptive data are recorded by transforming text entered on a computer screen with an input device into digital data, as recited in independent claims 1 and 21.

Elsmore discloses a method for measuring the thickness of a ferromagnetic layer formed over a conductive base layer (see Abstract). The system includes a probe 18 that provides output values in two dimensions corresponding to the modulation of the probe's magnetic field by the ferromagnetic and conductive layers (see Fig. 2 and col. 2, lines 51-55). The output values are used to determine a mapping between the detector output values and ferromagnetic layer thickness and standoff values (see col. 2, lines 55-57). The Office Action asserts that the standoff values that are stored for each measured thickness value correspond to the claimed descriptive data that are associated with coating thickness values and which provide information concerning the coating thickness values. However, Elsmore does not disclose that the standoff values are recorded by transforming text entered on a computer screen with an input device into digital data, as recited in independent claims 1 and 21. Thus, independent claims 1 and 21 are patentable over Elsmore.

Because claims 2, 4, 6, 8, 9, 23, 25, 26, 28, 30, 34 and 48 incorporate the features of claims 1 and 21, respectively, these claims also are patentable over

Elsmore for at least this reason, as well as for the additional features these claims recite. Thus, it is respectfully requested that the rejection be withdrawn.

V. 35 U.S.C. §103(a) Rejection over Elsmore

The Office Action rejects claims 3, 10, 13-16 and 22 under 35 U.S.C. §103(a) over Elsmore. The rejection is respectfully traversed.

The apparatus of independent Claim 10 includes a PCMCIA card that is connected to probe and which receives a first signal from the probe. The PCMCIA card includes means for converting the first signal into a second signal which is compatible with a standard PCMCIA output format.

The Office Action asserts that Elsmore's calibration controls 34, analog driver/receiver 24 and analog/digital conversion unit 36 collectively correspond to a "card" connected to the probe 18, as recited in claim 10. Applicants respectfully disagree. Elsmore discloses that all of the parts of the system shown in Fig. 2 are incorporated into a single unit (see col. 4, lines 63-65). In an alternative embodiment, the analog driver/receiver 24, an X-Y display 28 and the calibration controls 34 are configured as a stand alone eddy current instrument (see col. 4, line 68 to col. 5, line 3). However, Elsmore does not disclose that the analog/digital conversion unit 36 ("means for converting the first signal into a second signal") is included in the stand alone eddy current instrument. That is, Elsmore does not disclose that the analog/digital conversion unit 36 could have been included in the same device outside of a single unit containing the entire system. Regardless of Office Action's assertion that the PCMCIA format would have been obvious, there is insufficient evidence to support its conclusion that it would have been obvious to modify the calibration controls 34, the analog driver/receiver 24 and the analog/digital conversion unit 36 of Elsmore to be a "card", as recited in claim 10.

Simply because something can be modified and a person of ordinary skill was capable of making the modification does not mean that it would have been obvious to do so.

The PCMCIA card can be adapted to support a wide variety of peripheral devices, and due to its versatility, allows many types of probes to be incorporated into the thickness gauge (see col. 2, lines 58-61). For example, the PCMCIA card 40 can be modified to include hardware to support probes which measure thicknesses of nonmagnetic coatings on ferrous substrates, nonconductive coatings on nonferrous substrates, combination probes which measure both, or probes which ultrasonically measure coating thicknesses on nonmetals (see col. 4, lines 35-40). Elsmore is not concerned with supporting a variety of peripheral devices and probes, and does not disclose a structure that could be modified to include a PCMCIA card as recited in claim 10.

Thus, it would not have been obvious to modify the system disclosed by Elsmore to include a card connected to the probe, the card receiving a first signal from the probe and including means for converting the first signal into a second signal, as recited in independent Claim 10. Therefore, independent Claim 10 is patentable over Elsmore.

Because claims 3, 13-16 and 22 incorporate the features of claims 1, 10 and 21, respectively, these claims also are patentable over Elsmore for at least this reason, as well as for the additional features these claims recite. Thus, it is respectfully requested that the rejection be withdrawn.

VI. 35 U.S.C. §103(a) Rejection over Elsmore in view of Mulkey

The Office Action rejects claims 11 and 12 under 35 U.S.C. §103(a) over Elsmore in view of Mulkey et al. ("Mulkey"), U.S. Patent No. 5,138,268. The

rejection is respectfully traversed.

Because claims 11 and 12 incorporate the features of independent claim 10, and because Mulkey fails to overcome the deficiencies of Elsmore, these claims are patentable over the applied references for at least this reason, as well as for the additional features these claims recite. Thus, it is respectfully requested that the rejection be withdrawn.

VII. Claims 51 and 52

Independent claims 51 and 52 are presented for consideration and recite that the plurality of descriptive data are entered by touching a touch-sensitive computer screen that includes an electronic pictorial representation of a coated article. None of the applied references discloses these features. Thus, independent claims 51 and 52 are patentable over the applied references.

VIII. Conclusion

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

By:
David R. Kemeny
Registration No. 57241

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P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620